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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,446	12/31/2003	Rajnish Batlaw	5343B	9821

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Spartanburg, SC 29304

EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,446

Applicant(s)

BATLAW, RAJNISH

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 10/23/04.

The new grounds of rejection as set forth below are necessitated by applicant's amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 5-6, and 9-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 2, and 5 have been amended to recite "anhydrous" black gravure ink. It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase "anhydrous" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. It is noted that examples

1-2 on page 10 of the present specification are described as toluene-based inks, however, there is no evidence that these inks are anhydrous.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-2, 5-6, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (U.S. 5,886,091) in view of Baumgartner et al. (U.S. 4,812,141).

The rejection is adequately set forth in paragraph 6 of the office action mailed 6/23/04 and is incorporated here by reference.

Response to Arguments

6. Applicant's arguments regarding Krutak et al. (U.S. 5,194,463), Cross et al. (U.S. 4,284,729), and Batlaw (U.S. 5,429,841) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

7. Applicant's arguments filed 10/23/04 have been fully considered but, with the exception of arguments relating to Krutak et al., Cross et al., and Batlaw, they are not persuasive.

Specifically, applicant argues that neither Harris et al. or Baumgartner et al. disclose polymeric colorant toner exhibiting λ_{max} absorption between about 550 and 610 nm wherein the

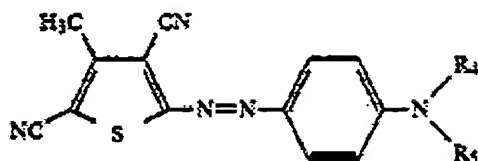
toner comprises nonionic chromophore component and wherein the toner component comprises polyoxyalkylene chains comprising at least a majority of C₃ or higher alkylene oxide monomers.

However, it is agreed that Harris et al. do not disclose polymeric colorant toner as presently claimed which is why Harris et al. is used in combination with Baumgartner et al.

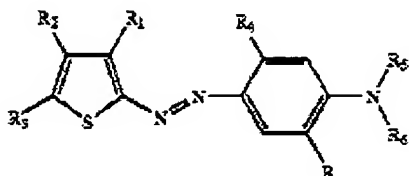
Harris et al. disclose gravure ink comprising colored polyurethane obtained from polyoxyalkylene containing chromophore but does not disclose specific polyoxyalkylene containing chromophore as presently claimed.

Baumgartner et al., which is also drawn to gravure ink, disclose the use of colored thermoplastic resin that comprises colorant in the form of oxyalkylene substituted chromophore wherein the chromophore is nonionic as presently claimed and the polyoxyalkylene chains contain ratio of polypropyleneoxy to polyethyleneoxy of, for instance, 3:1 to 4:1 as presently claimed. Thus, given that Baumgartner et al. disclose alkyleneoxy substituted chromophore identical to that presently claimed wherein the chromophore is nonionic and comprises azo, anthraquinone, and indigoid chromophore which are identical to the chromophores utilized in the present invention and the ratio of polypropyleneoxy to polyethyleneoxy is identical to that presently claimed, it is the examiner's position, absent evidence to the contrary, that the colorant would intrinsically exhibit maximum absorption at same λ as presently claimed.

Further evidence to support examiner's position is found in state-of-the-art references such as Xia et al. (U.S. 2004/0192797) which discloses colorant identical to that disclosed in Baumgartner et al. Specifically, Baumgartner et al. (col.12, line 1) disclose colorant of the formula:



while Xia et al. disclose colorant of the formula:



where R_1 and R_3 are cyano, R_2 is C_1 - C_{20} alkyl, R_4 is H, R is H, and R_5 and R_6 are each polyoxyalkylene constituent and thus, the colorant of Xia et al. is identical to that disclosed by Baumgartner et al. Xia et al. disclose that the above colorant possesses λ_{\max} of 560-610 nm (paragraphs 22, 23, and Table 1). Thus, it is clear that the colorants of Baumgartner et al. do intrinsically possess λ_{\max} as presently claimed.

Applicants also argue that the disclosure of broad families of colorant by Baumgartner et al. does not provide teaching of colorant toner species having maximum absorption as recited in the present claims.

However, Baumgartner et al. disclose more than broad families. In the examples, Baumgartner et al. disclose specific colorants comprising chromophore and polyoxyalkylene chains identical to those utilized in the present invention.

Applicants also argue that even if the broad disclosure of colorants by Baumgartner et al. did encompass colorants that include those with λ_{\max} as presently claimed, there is no motivation to select out from this large group those colorants with the claimed λ_{\max} .

However, as noted above, the examples of Baumgartner et al. disclose specific types of colorants. Further, the examples note that the use of such colorants produces colored resin wherein the colorant performs better with respect to non-extractability (Tables 9-10), i.e. reduced color migration. Thus, there is motivation to select out specific types of colorants from the broad disclosure of Baumgartner et al.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

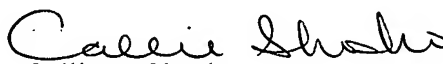
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
1/21/05